



UNITED STATES PATENT AND TRADEMARK OFFICE

H.A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/516,310

07/27/2005

Ken Sakamura

263132US90XPCT

3870

22850

7590

09/06/2006

C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/516,310

Applicant(s)

SAKAMURA ET AL.

Examiner

Daniel A. Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/05/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Applicant's initial filing of 7/27/05, which has been placed in the electronic file of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Bashan et al. (US 6,045,043).

Re claim 1: All of the elements can be seen in figure 2, and in greater detail in figure 3. There is an IC chip that comprises a CPU, indicated by the microprocessor 14. There are a contact field 11 which the microprocessor/CPU connects to via wires 13, as well as an antenna interface that the microprocessor/CPU connects to via connection 17. Thus there are necessarily interfaces inside the microprocessor which interface with the wires 13 and the connection 17 to interface with the contact field and contactless field respectively. These can be seen in figure 3, where the different ports on the microprocessor itself can be seen.

Re claim 2: In Bashan et al., the contact interface is (see figure 2) connectable to an external electronic device via the contact field 11 having contacts 12.

Art Unit: 2876

Re claim 3: In Bashan et al., the contactless interface is (see figure 2) connectable to an external electronic device via an antenna interface 16 including an antenna 15.

It is noted that in Bashan et al. the contact and contactless interfaces are provided at the same location, and thus the limitations of claim 4 are not met.

Claims 1-7 rejected under 35 U.S.C. 102(b) as being anticipated by Kreft (US 5206495).

Re claims 1-3: See figure 1; a discussion can be made similar to the discussion with respect to claims 1-3 of Bashan.

Re claims 4: As figures 1 and 2 show, different contacts are used to make connections with the contactless antennas as with the contact fields.

Re claim 5: In Kreft, the physical shape of the chip and of the card are designed to achieve a good wired and wireless connection. The contacts are a spaced apart field of contacts, and the antenna is a coil, for greater transmission.

Re claim 6: Antennas 4 and 5 can be seen in figures 1 and 2 of Kreft. Kreft is clearly part of an overall card.

Re claim 7: The card of Kreft connects to the IC chip of Kreft and can act a contactless IC card (see for example abstract; figure 1).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2876

Claims 1, 8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Nelson et al. (US 6377218).

Re claims 1 and 8: See figure 2 of Nelson. In Nelson there is an IC chip (microcontroller 230) on a card. It has a connection to a contacting interface 240 and another connection to a contactless interface 210. It is designed so that the contacting interface 240 connects, via a bus 100, with a computer system 120. The computer system may be a laptop (column 3, lines 29-31) in which case the system 120 is clearly a 'mobile terminal device.' The shape of the card is clearly complementary to the shape of the chip and further the card and the port of the laptop are designed to accommodate the wireless communication which is to occur. The card is of a complementary shape to receive the chip and the computer (such as a laptop) is of a complementary shape to receive the card with the chip on it.

Re claim 10: If one considers the microcontroller 230 of Nelson to be the chip and the entire card to be the portable electronic device having a second chip, namely the second controller 220, then the limitations of the claim are met. Communication is enabled to the outside via antenna 205.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2876

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Kreft.

Nelson fails to show whether his contact and contactless exchanges are on the same ports of the chip, and thus the limitations of claim 4 are not positively met, even if they are probably met.

Nelson et al. teaches in figures 1 and 2 that different contacts are used to make connections with the contactless antennas as with the contact fields.

In view of Nelson's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use locations on the chip for the contact and contactless interfaces because in this way, both forms of communication can occur simultaneously.

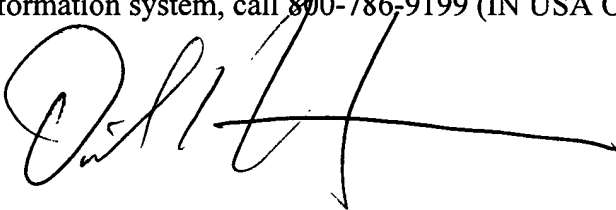
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'D. Hess', with a long horizontal stroke extending to the right.

Daniel A Hess
Examiner
Art Unit 2876

8/7/06